

ESTTA Tracking number: **ESTTA344670**

Filing date: **04/28/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	MedicAlert Foundation United States, Inc.
Granted to Date of previous extension	04/28/2010
Address	2323 Colorado Avenue Turlock, CA 93582 UNITED STATES
Attorney information	Lauren Estrin Kilpatrick Stockton LLP 1100 Peachtree Street Suite 2800 Atlanta, GA 30309 UNITED STATES lestrin@kilpatrickstockton.com, malexander@kilpatrickstockton.com, miskowitz@kilpatrickstockton.com, tadmin@kilpatrickstockton.com

### Applicant Information

Application No	77796576	Publication date	12/29/2009
Opposition Filing Date	04/28/2010	Opposition Period Ends	04/28/2010
Applicant	Safeguard Security and Communications, Inc. 8454 N. 90th Street Scottsdale, AZ 85258 UNITED STATES		

### Goods/Services Affected by Opposition

Class 044. First Use: 2009/07/05 First Use In Commerce: 2009/07/05  
All goods and services in the class are opposed, namely: Medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	695056	Application Date	10/20/1958
Registration Date	03/22/1960	Foreign Priority Date	NONE


Word Mark	MEDIC ALERT
Design Mark	
Description of Mark	NONE
Goods/Services	Class U100 (International Class 035, 036, 037, 038, 039, 040, 041, 042). First use: First Use: 1958/03/13 First Use In Commerce: 1958/05/19 SERVICE OF MAINTAINING FILES SETTING FORTH THE DISABILITIES OR OTHER MEDICAL CONDITIONS, AND THE IDENTIFICATION, OF PERSONS WHO MAY BE STRICKEN OR INJURED, AND FROM WHICH FILES INFORMATION IS MADE AVAILABLE TO AUTHORIZED PERSONS OR AGENCIES IN ORDER TO HELP THE STRICKEN OR INJURED PERSON

U.S. Registration No.	1288903	Application Date	05/16/1983
Registration Date	08/07/1984	Foreign Priority Date	NONE
Word Mark	MEDIC ALERT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 Bracelets and Necklaces Containing Emblems with Medical Information Thereon Class 016. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 Wallet Cards Providing Medical Information Concerning a Particular Person's Health Condition		

U.S. Registration No.	3334545	Application Date	10/18/2005
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	MEDICALERT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/08/18 First Use In Commerce: 2005/08/18 electronic storage devices, namely flash drives for the collection, storage, management, retrieval, monitoring and communication of personal and/or medical information; software for the collection, storage, management, retrieval, monitoring and communication of personal and/or medical information Class 014. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 jewelry containing emblems with personal and/or medical information thereon		

	<p>Class 016. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 printed materials, namely pamphlets, brochures, booklets, posters, and manuals in the fields of health, personal safety, and health and emergency response procedures; membership identification cards, not magnetically encoded, providing personal and/or medical information thereon</p> <p>Class 035. First use: First Use: 1958/03/13 First Use In Commerce: 1958/03/13 data processing services, namely, the collection of personal and/or medical information in a computer database; data and information management, namely, management of computerized files containing personal and/or medical information</p> <p>Class 038. First use: First Use: 1958/03/13 First Use In Commerce: 1958/03/13 Communication, namely, electronic transmission of personal and/or medical information</p> <p>Class 039. First use: First Use: 1958/03/13 First Use In Commerce: 1958/03/13 Electronic storage of personal and/or medical information</p> <p>Class 044. First use: First Use: 1958/03/13 First Use In Commerce: 1958/03/13 Providing medical information to emergency responders, medical personnel, members, and designees of members via a 24-hour monitoring service; providing medical information to allow members to update their medical and personal files</p>
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U.S. Registration No.	1792526	Application Date	01/25/1993
Registration Date	09/14/1993	Foreign Priority Date	NONE
Word Mark	MEDIC ALERT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 bracelets and necklaces containing emblems with medical information thereon</p> <p>Class 016. First use: First Use: 1956/07/14 First Use In Commerce: 1956/07/14 wallet cards providing medical information concerning a particular person's health condition</p> <p>Class 042. First use: First Use: 1958/03/13 First Use In Commerce: 1958/03/19 service of maintaining files setting forth the disabilities or other medical conditions, and the identification, of persons who may be stricken or injured, and from which files information is made available to authorized persons or agencies in order to help the stricken or injured person</p>		
U.S. Application No.	77879838	Application Date	11/24/2009

Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MEDICALERT FOUNDATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 044. First use: First Use: 1958/03/19 First Use In Commerce: 1958/03/19 Providing personal medical information of members to emergency responders, medical personnel, members and designees of members through a telephone information service staffed 24 hours a day; maintaining and providing for updating of personal medical records, data and information of members for immediate availability to medical and emergency response personnel on a 24 hour basis by calling telephone numbers provided on bracelets or other identifying emblems worn by members; operation of medical information call center to provide personal medical data of members to emergency responders and medical personnel and to notify family members, caregivers and other designees of members in the event that illness, injury or other emergency befalls a member; providing contact information services for law enforcement personnel or other first responders to assist in identifying adults and children whose ability to communicate may be limited and returning them to caregivers</p> <p>Class 045. First use: First Use: 1958/03/19 First Use In Commerce: 1958/03/19 Charitable foundation services in the field of maintaining and providing personal medical and identification information of members to emergency responders and medical personnel and giving notice to relatives, caregivers or other designees in the event members suffer illness, injury or other emergency</p>		

Attachments	78735582#TMSN.jpeg ( 1 page )( bytes ) 74351641#TMSN.gif ( 1 page )( bytes ) 77879838#TMSN.jpeg ( 1 page )( bytes ) MedicAlert NOA.pdf ( 5 pages )(22095 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.


Signature	/Lauren T. Estrin/
Name	Lauren Estrin
Date	04/28/2010

MEDICALERT FOUNDATION	)	
UNITED STATES, INC.,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
v.	)	Serial No. 77796576
	)	
SAFEGUARD SECURITY AND	)	
COMMUNICATIONS, INC.	)	
	)	
Applicant.	)	

Opposer MedicAlert Foundation United States, Inc. will be damaged by the registration of the SAFEGUARD MEDALERT mark, which is the subject of Application Serial No. 77796576, and states the following for its Notice of Opposition to that application:

2. Opposer is the owner of the distinctive and famous trademark MEDICALERT used alone and together with other designs (the “MEDICALERT Marks”), for various medical identification jewelry and monitoring services.

4. Opposer is the owner of following registrations and application of the MEDICALERT Marks, all of which are valid and in full force and effect:

Registration No.	Mark
695056	MEDICALERT
1288903	MEDIC ALERT
3334545	MEDICALERT
1792526	
77879838	MEDICALERT FOUNDATION

5. Opposer uses and promotes the MEDICALERT Marks in such a way that the public associates the marks exclusively with Opposer.

6. On August 4, 2009, Applicant Safeguard Security and Communications, Inc. (“Applicant”) filed application Serial No. 77796576 to register the mark SAFEGUARD MEDALERT for services described as “medical assistance services provided via telecommunication and global computer networks for individuals with health problems through the use of wearable medical devices with automated alert and monitoring capacity,” in International Class 44. Applicant’s mark was published in the *Official Gazette* on December 29, 2009.

7. Over fifty years prior to Applicant’s first use of its SAFEGUARD MEDALERT mark, and as a result of widespread advertising and promotion by Opposer, the

MEDICALERT Marks acquired a high degree of recognition, fame, and distinctiveness as a symbol of the quality of goods and services offered by Opposer. Specifically, the MEDICALERT Marks are covered by federal registrations, have been the subject of extensive advertising and publicity, and have been sold throughout the United States and the world. The public and the trade are familiar with and identify the MEDICALERT Marks with Opposer and, by reason of this identification, goods and services associated with the mark are understood by the public and trade to be produced, marketed, and offered under Opposer's authority or otherwise derived, authorized, or promoted by Opposer. As a result of their fame and notoriety, the MEDICALERT Marks are entitled to a broad scope of protection.

8. The salient element of Applicant's SAFEGUARD MEDALERT mark is virtually identical in appearance, sound and commercial impression to Opposer's MEDICALERT Marks, and is being used for services nearly identical and closely related to the goods and services for which Opposer uses its MEDICALERT Marks.

9. Based on the similarities of the marks and the goods and services, the relevant public is likely to be confused into believing that Applicant's services, as offered under the SAFEGUARD MEDALERT mark, emanate from Opposer, or are authorized, licensed, endorsed, promoted or sponsored by Opposer. Registration of Applicant's SAFEGUARD MEDALERT mark on the Principal Register thus would be inconsistent with Opposer's prior rights in its famous and distinctive MEDICALERT Marks.

10. Opposer will be damaged by the registration of Applicant's SAFEGUARD MEDALERT mark because it so resembles Opposer's previously used and well-known marks as to be likely, when used on or in connection with the services identified in the

subject application, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052.

11. Opposer will be further damaged by the registration of Applicant's SAFEGUARD MEDALERT mark because the mark is likely to dilute the distinctiveness of the famous MEDICALERT Marks by eroding consumers' exclusive identification of these marks with Opposer, and/or by tarnishing and degrading the positive associations and prestigious connotations of these famous marks, and/or by otherwise lessening the capacity of the marks to identify and distinguish Opposer's goods and services in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

12. Opposer therefore requests that registration of the mark underlying Application Serial No. 77796576 be refused, and this Notice of Opposition be sustained in Opposer's favor.

This 28th day of April, 2010.

KILPATRICK STOCKTON LLP  
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Atlanta, Georgia 30309-4530  
(404) 815-6500 (telephone)  
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Respectfully submitted,

/s/ Lauren T. Estrin  
Miles Alexander  
Lauren T. Estrin

Attorneys for Opposer



MEDICALERT FOUNDATION	)	
UNITED STATES, INC.,	)	
	)	
Opposer,	)	Opposition No. _____
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v.	)	Serial No. 77796576
	)	
SAFEGUARD SECURITY AND	)	
COMMUNICATIONS, INC.	)	
	)	
Applicant.	)	

This is to certify that the attached Notice of Opposition has been served upon Applicant's counsel of record by depositing a copy in the United States mail as first-class mail, postage pre-paid, addressed as follows:

This 28th day of April 2010.

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